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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/751,510 | 01/06/2004 | Robert W. Jones | 14991.01 | 3347 |

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EXAMINER

DRODGE, JOSEPH W

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1723

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,510

Applicant(s)

JONES, ROBERT W.

Examiner

Joseph W. Drodge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 12-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Pourdeyimi et al PGPUBS Document US2005/0034376, published 2/17/05 and filed 09/23/2003. Pourdeyimi et al disclose a foam filter insert, of open cell foam material combined with a gutter having all of the cross-sectional features of filter insert and gutter of the instant claims, including the angled or triangular side between front edge of outer portion of upper side and lower side that is forward of rear edge of lower side, so as to generally correspond to the generally triangular shape of outer surface of the corresponding gutter while leaving some void space between filter insert and lower and outer sides of the gutter (see especially figure 1B and paragraphs 20, 53, 69 and 71).

As to claim 16, figure 1B also shows the gutter inner lip portion extending downward and inward that may bear against the filter insert depending upon how the material is cut prior to fitting into the gutter (paragraph 69).

For claim 17, figure 1B also illustrates the gutter and filter insert being located below the draining eave of a roof.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 13,15,19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pourdeyhimi et al in view of Dugan patent 3,855,132 of record.

Claim 13 differs in requiring foam material to have 10 to 20 cells per square inch, a limitation taught by Dugan at column 2, lines 36-38. It would have been obvious to have utilized such open cell parameter of Dugan with the foam insert of Pourdeyhimi, so as to assure adequate water flow through the foam without allowing significant contaminant flow therethrough.

Claims 15 and 19 differ in requiring foam sections of four feet in length, Pourdeyhimi broadly stating that the insert can be cut prior to insertion (paragraph 21). Dugan teaches a gutter filter insert with such lengths of foam at column 2, lines 27-34. It would have also been obvious to one of ordinary skill in the art to have manufactured the foam of Pourdeyhimi et al as approximate four foot sections, as taught by Dugan to facilitate ready insertion and removal for cleaning of the foam.

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For claim 20, Pourdeyhimi et al also disclose the filter insert being readily placed or fitted into the gutter, hence also removable from the gutter (paragraphs 20 and 21).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pourdeyhimi et al in view of Dugan as applied to claim 13 above, and further in view of Etani patent 3,946,362 of record. Claim 14 specifies polyether foam, Dugan teaching polyurethane foam and Etani teaching that polyether foam is a component of polyurethane foam filters. It would have been obvious to have utilized polyether or polyurethane foam for the filter insert of Pourdeyhimi et al, in view of Dugan and Etani, since these materials are readily available and easily manufactured and processed.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Poureyhimi et al in view of Dugan as applied to claim 17 above, and further in view of Hunt patent 5,103,601 of record. Claim 18 differs in requiring gutter spikes extending through the gutter upper lip to secure gutter to building structure. It would have been further obvious to one of ordinary skill in the art to have utilized the spikes of Hunt in the installation of gutter and insert of Pourdeyhimi, in order to firmly secure gutter to building so that it does not fall off.

Applicant's arguments with respect to claims 12-20 have been considered but are moot in view of the new ground(s) of rejection. The recently available Pourdeyhimi et al publication is similar in scope to the Dugan patent of record, however more clearly teaching the claimed orientation of the triangular or angled side of the foam insert in order to more closely be aligned with contemporary gutters having a triangular outer surface .

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Drodge at telephone number 571-272-1140. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at 571-272-1151. The fax phone number for the examining group where this application is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or Public PAIR, and through Private PAIR only for unpublished applications. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD

June 14, 2005


JOSEPH DRODGE
PRIMARY EXAMINER